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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/717,926	11/21/2003	Tamio Noguchi	MERCK-2801	7555
23599	7590	05/02/2006		EXAMINER
MILLEN, WHITE, ZELANO & BRANIGAN, P.C. 2200 CLARENDON BLVD. SUITE 1400 ARLINGTON, VA 22201			LE, HOA T	
			ART UNIT	PAPER NUMBER
			1773	

DATE MAILED: 05/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/717,926	NOGUCHI, TAMIO	
	Examiner H. T. Le	Art Unit 1773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 14 December 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 10-13, 19, 20 and 23 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-9, 14-18, 21, 22 and 24-26 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Election/Restrictions

2. Applicant's election with traverse of claims 1-9, 14-18, 21, 22, and 24-26 in reply filed on December 14, 2005 is acknowledged.¹ The traversal is on the ground that "the claims to the method of making the pigment, classified in group II, are related to the claims of group I as combination to subcombination." This is not found persuasive because it is incorrect. Subcombination and combination relationship can only exist between two products, not between a product and a process. As stated in the last office action, the relationship between group I and II inventions is product and process of making such product. And as shown in the last office action, there exists at least one materially different method of making the same particles as claimed. The requirement is still deemed proper and is therefore made FINAL.

Accordingly, claims 10-13, 19, 20 and 23 stand withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention. Note that claim 19 is now added to group II invention (non-elected) because it has been amended to a method claim.

¹ Note that claim 19 now belongs to group II of the non-elected invention because it has been amended to a method claim.

Response to Arguments

3. **Claims 1-3, 6-9, 14-18, 21 and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by the Bauer patent (US 6,630,018) as set forth in the last office action and further discussed below.**
4. **Claims 1, 6-9, and 14-18 are rejected under 35 U.S.C. 102(b) as being anticipated by the patents Linton and Nitta (US 3,087,828 and US 5,223,034) as set forth in the last office action and further discussed below.**
5. **Claims 4, 5 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over the all the patents discussed above as applied to claim 1, and further in view of the Franz '793 patent (US 4,867,793)) as set forth in the last office action and further discussed below.**
6. With regard to the Bauer patent, Applicant argues that “[p]atentees teach that these layers can be put together as A, B, C or in a variety of other orientations... As a result, it is not seen of one of ordinary skill in the art is given sufficient direction so as to be taught the particular composition of layers claimed in, for example, independent claim 1.” First, independent 1 does not require any particular order of the coating layers. Only claims 2-3 require specific order for the coating layers, and such order is taught in the Bauer patent as discussed in the last office action. There, the examiner clearly stated that teachings of claims 2-4 are taught in examples 5-7. The argument relating to non-elected method claims is deemed moot as they have been withdrawn from consideration as discussed in section 2 above.

7. With regard to the Linton patent, applicant argues that “Linton predominantly directed to incorporation of additional metals within a titanium dioxide layer... To the extent that a second layer of metal oxide is

disclosed a long list of possible metal oxides is given.” Note that the independent claim 1 also permits a long list of metal oxides to choose from as coating well.

8. With respect to Nitta, applicant argues that “the generic disclosure (for example, at column 3, lines 22-30) requires judicious selection by one of ordinary skill in the art.” Note that the independent claim 1 recites a list of metal oxides to choose from as coating as well.

Conclusion

9. Applicant's arguments filed December 14, 2005 have been fully considered but they are not persuasive for the reasons set forth above. However, the arguments are effective to overcome the two Mead-corporation brochures.

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action.

In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to H. T. Le whose telephone number is 571-272-1511. The examiner can normally be reached on 10:00 a.m. to 6:30 p.m., Mondays to Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on 571-272-1284. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



H. T. Le
Primary Examiner
Art Unit 1773

April 27, 2006